

REMARKS

The Office Action mailed June 21, 2006 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Subject Matter Indicated Allowed or Allowable

Applicants gratefully acknowledge the indication of allowance of claims 10 and 18.

Rejection(s) Under 35 U.S.C. § 103 (a)

Claims 1-3, 5-9, 11, 13-17 and 19-22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ikushima et al. (U.S. pat. no. 4,199,222) in view of Huber (DE 199 58 548 A1¹). Claims 4 and 12 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ikushima et al. (U.S. pat. no. 4,199,222) in view of Huber (DE 199 58 548 A1) as applied to claim 1 or 2, and further in view of Muller et al (U.S. pat. no. 5,401,270).

Applicants respectfully traverse.

Ikushima is directed to a device that is designed to prevent back-reflected radiation from interfering with laser operation. Specifically, Ikushima disposes a waveguide 2 between the laser 1 and transmitting fiber 3 in order to prevent a portion of light impinging the input end of transmitting fiber 3 from being reflected back into the active region 4 of the semiconductor laser 1. Such back-reflection would interfere with laser operation because “the drive current to optical output characteristic, spectrum and modulated optical output wave of the laser are effected by the reflected optical beam.”²

By comparison, Huber is directed to an optical coupler for evenly distributing light introduced into a pair of waveguides 3,4. A first waveguide 2 is provided for directing the introduced light into the pair of waveguides 3,4, the first waveguide including a matt input side, or having “scattering centers” that are “uniformly distributed in the volume” thereof.

¹ The Office Action ascribes the wrong reference number, DE 199 58 547 A1, to this reference.

² Ikushima, col. 1, ll. 25-30.

It can be seen that the objects of Ikushima and Huber are different, and one of ordinary skill in the art, practicing the teachings of Ikushima and seeking to prevent back-reflected light from interfering with laser operation, would not look to Huber for guidance as Huber is silent on the subject of back-reflection and is concerned with different issues altogether. The notion that Ikushima and Huber can be combined in this case is grounded in impermissible hindsight. It will be appreciated that, according to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.³

In the present case, at least the first criterion—that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings—fails, and the 35 U.S.C. §103(a) rejections based on the combination of Ikushima and Huber should be withdrawn.

Conclusion

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance.

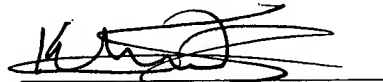
If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

³ M.P.E.P. § 2143.

Please charge any additional required fees, including those necessary to obtain extensions of time to render timely the filing of the instant Amendment and/or Reply to Office Action, or credit any overpayment not otherwise credited, to our deposit account no. 50-1698.

Respectfully submitted,
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